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Attorney Docket No. P21470

In re application of : Markus OECHSLE et al.

Serial No. : 09/936,516

Group Art Unit: 1731

(National Stage of PCT/EP00/02250)
I.A. Filed : March 14, 2000

Examiner: M. Halpern

For : DEVICE FOR DETERMINING THE CHARACTERISTICS
OF A RUNNING MATERIAL

THE COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

RECEIVED

JAN 17 2003

TC 1700

Sir:

Transmitted herewith is an election with traverse in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
☐ A Request for Extension of Time.
☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 32	32*	0	x 9=	\$	x 18=	\$0.00
Indep. Claims: 3	*3*	0	x 42=	\$	x 84=	\$0.00
Multiple Dependent Claims Presented			+140=	\$	+280=	\$0.00
Extension Fees for Month				\$		\$0.00
Total:				\$	Total:	\$0.00

*If less than 20, write 20

**If less than 3, write 3

☐ Please charge my Deposit Account No. 19-0089 in the amount of \$_____.

N/A A Check in the amount of \$_____ to cover the *filing/extension* fee is included.

☒ The Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 CFR 1.136) (a)(3)

Reg. No. 45,294
Neil F. Greenblum
Reg. No. 28,394

P21470.A05



#10/BM
1-23-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Markus OECHSLE et al.

Art Unit: 1731

Appln. No. : 09/936,516
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For : DEVICE FOR DETERMINING THE
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MATERIAL

ELECTION WITH TRAVERSE

RECEIVED

Assistant Commissioner of Patents
Washington, D.C. 22039

JAN 17 2003

TC 1700

Sir:

In response to the Official Action of December 16, 2002, in which a one-month statutory period for response was set to expire on January 16, 2003, Applicant elects the species defined by the Examiner as Group (a), i.e., claims 33 and 84-88. The above-noted election is made with traverse for the reasons set forth below.

REMARKS

Upon entry of the present election, Applicant will have elected with traverse the species defined as Group (a) on which at least claims 33 and 84-88 read.

In the election of species requirement, the Examiner set forth a requirement to elect

one of three species of the invention under the provisions of PCT Rule 13.1 and 13-2 because they lack “unity of invention”. The groups delineated by the Examiner are as follows:

Group (a), claims 84-88;

Group (b), claims 89-91; and

Group (c), claim 73.

However, the Examiner has failed to consider the fact that claims 33-104 are pending. Furthermore, the Examiner has indicated, incorrectly, that there are no generic claims. It is respectfully submitted that the Examiner required the instant election without carefully evaluating the claims. Each of the above-noted claims clearly depend from the same independent claim, i.e., independent claim 33. Thus, at least claim 33 must be generic. Furthermore, the Examiner erred in issuing this election of species requirement as it is based on a complete misunderstanding of restriction practice in National Stage Applications.

In the Office Action, the Examiner asserts that the inventions are distinct species because “they are not so linked as to form a single general inventive concept”. The Examiner also indicated that no claims are generic, even though each of the above-noted claims clearly depend from independent claim 33. Finally, the Examiner argued that the species do not relate to a single general inventive concept because “they lack the same or corresponding technical features for the reasons: Species (a) includes the species of an apparatus wherein the measuring device is attached to a frame, not included in species (b) or (c). Species (b)

includes the species of an apparatus wherein the measuring device is attached to a beam, not included in species (a) or (c). Species (c) includes the species of an apparatus wherein the measuring device is attached to a machine, not included in species (a) or (b).” Applicant respectfully traverses the election requirement as it is entirely improper and clearly erroneous.

Applicant submits that the Examiner’s basis for the election requirement is improper for the following reason. First of all, the Examiner has misinterpreted the “special technical feature” standard and has essentially turned it on its head. The standard, as described clearly in M.P.E.P. 1850, is not whether one group of claims has a feature which is not in another group (i.e., which structure the measuring device is attached to), but whether the groups can be read to have a common technical relationship, i.e., whether a special technical feature is common to the groups. Accordingly, if each of the groups can be read to have this special technical feature, then they cannot be restricted. In this case, the technical relationship or technical feature is clear from the fact that each of the claim groups depend from claim 33, i.e., at least every feature recited in claim 33 is common to each of the claim groups identified by the Examiner.

Further, M.P.E.P. 1850 paragraph “A” makes clear that dependent claims cannot be separated from independent claims because the “unity of invention” standard must be evaluated on the basis of *independent claims only*. Accordingly, since the only independent

claims are 33, 99 and 100, and since the claims identified by the Examiner clearly depend from independent claim 33, none of the identified claims can be properly restricted under the unity of invention standard. Indeed, at least all of claims 33-98 must be examined together under the unity of invention standard. Moreover, because independent claims 33, 99 and 100 have at least one, if not many common special technical features, all of claims 33-104 must be examiner together. Thus, Applicant submits that a species election is an entirely improper basis for restriction under the unity of invention standard.

Accordingly, Applicant submits that under the “unity of invention” standard, the Examiner has set forth no proper basis for restricting the invention to any of the groups. For this reason alone, it is submitted that an election or a restriction is inappropriate and that all the claims in the present application should be examined together.

Furthermore, it is believed that the features described in each of Groups (a)-(c) are not materially different, so as to constitute distinct inventions, for examination purposes. As the Examiner will probably acknowledge, they all depend from claim 33 and must therefore have at least the features in claim 33 in common. Therefore, the searches must be overlapping for the groups. Thus, no undue burden is placed on the Examiner when examining all of the claims together. Consequently, it is believed that all the claims, i.e., 33-104 relate to a single inventive concept which share a common technical relationship.

Finally, the election of species requirement set forth by the Examiner omits one of

the two criteria for a proper restriction requirement now established by the U.S. Patent and Trademark Office policy. As set forth in M.P.E.P. § 803 "an appropriate explanation" must be set forth by the Examiner as to the existence of a "serious burden" if the restriction were not required. By virtue of the Examiner's requirement and because the claims of the various groups are so closely related, i.e, they have a technical relation related to the fact that they recite at least the common features of claim 33, it is submitted that there is no serious burden on the Examiner in examining all of the claims together. Furthermore, as noted above, the search for all of the claims includes a significant amount of overlap. Thus, no serious burden would come to bear on the Examiner.

For all these reasons, and consistent with the Office policy as set forth in M.P.E.P. § 803 and 1850, Applicant respectfully requests that the Examiner reconsider the position taken in the above-mentioned Official Action and withdraw the election requirement in the present application. Accordingly, the Examiner's election requirement is improper and has been traversed for the reasons set forth above.

Nevertheless, in order to be fully responsive, Applicant has elected with traverse the invention defined by the Examiner as Group (a), i.e., claims 33 and 84-88, in the event that the Examiner chooses not to reconsider and withdraw the election of species requirement.

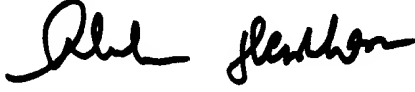
Should the Examiner have any questions or comments regarding the present response or this application, the Examiner is respectfully invited to contact the undersigned at the

P21470.A05

telephone number listed below.

The Commissioner is hereby authorized to charge any additional fee necessary to have this paper entered to Deposit Account No. 19-0089.

Respectfully submitted,
Markus OECHSLE et al.


Reg. No. 45,294

Neil F. Greenblum
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January 15, 2003
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